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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,424	02/13/2004	Robert H. Wollenberg	T-6319 (538-67)	9079

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EXAMINER	
LARKIN, DANIEL SEAN	
ART UNIT	**PAPER NUMBER**
2856	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/779,424	WOLLENBERG, ROBERT H.	
	Examiner	Art Unit	
	Daniel S. Larkin	2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,19-24 and 26-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9,10 and 39* is/are allowed.

6)☒ Claim(s) *1-8, 19-24, and 26-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *16 February 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Acknowledgment is made of Applicants cancellation of claims 11-18.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. 4 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 4 and 37: In view of the fact that applicant elected ashless dispersant as a species in claims 3 and 36, claims 4 and 37 now fail to further limit the claimed invention, since this limitation as presented in claims 4 and 37 is redundant. Additionally, since ashless dispersants were elected, the other "additives" in the claim may be patentably distinct from ashless dispersants, and therefore, need to be deleted from the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 6, 7, and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,427,834 (Martin) in view of In re Venner.

With respect to the limitations of claim 1, the reference to Martin discloses a testing process for the evaluation of a dispersant-VI improver product, whereby dispersancy performance of a plurality of samples is compared, TABLE I. In each sample, a major amount of at least one base oil is used; a minor amount of a lubricating additive is used; and the mixture of the base oil and the additive is mixed with a base insoluble-oil material. The dispersancy of each sample is measured and recorded as a ratio in TABLE I, col. 11, lines 20-68. The reference to Martin fails to disclose automatically outputting the results.

The courts have ruled that it is well settled that it is not invention to broadly provide a mechanical or automatic means to replace activity which has accomplished the same result (In re Venner, 120 USPQ 192 (CCPA 1958)). Providing automation to previously manual technique would be obvious to one of ordinary skill in the art as a means of processing more sample more efficiently and without potential human error.

NOTE: Applicants amendment to add the phrase "high throughput" does not change the steps of the claim. This phrase fails to appear anywhere within the body of the claim and is given no patentable weight. Additionally, the phrase "under program code", is also not given patentable weight because this phrase or concept also fails to appear within the body of the claim.

With respect to the limitation of claim 2, the reference discloses that the base oil may comprise mineral lubricating oils.

With respect to the limitation of claims 3 and 4, the reference to Martin discloses that two different ashless dispersants, Amoco 9250 and Lubrizol 6401, were used in comparison dispersancy tests.

With respect to the limitations of claims 6 and 7, the reference to Martin discloses that the mixture of the base oil and the additive is mixed with a sludge containing oil.

With respect to the limitations of claims 19-22, the reference to Martin discloses that two drops of each lubricating oil composition/solution is placed with an eyedropper on separate filter papers.

With respect to the limitation of claims 23 and 24, the reference to Martin discloses that the lubricating oil composition is shaken to homogenize the sample. The examiner argues that shaking the sample is functionally equivalent to mechanically stirring the sample to achieve homogenization of the sample.

6. Claims 1-8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,384,138 (Karll et al.) in view of In re Venner.

With respect to the limitations of claim 1, the reference to Karll et al. discloses a process of manufacturing phenols and a testing process for the evaluation of a Mannich product, whereby dispersancy performance of a plurality of samples is compared, TABLE I. In each sample, a major amount of at least one base oil is used; a minor amount of a lubricating additive is used; and the mixture of the base oil and the additive is mixed with a base insoluble-oil material. The dispersancy of each sample is

measured and recorded as a ratio in TABLE I, col. 6, lines 15-68 and col. 7, lines 1-13. The reference to Karll et al. fails to disclose automatically outputting the results.

The courts have ruled that it is well settled that it is not invention to broadly provide a mechanical or automatic means to replace activity which has accomplished the same result (In re Venner, 120 USPQ 192 (CCPA 1958)). Providing automation to previously manual technique would be obvious to one of ordinary skill in the art as a means of processing more sample more efficiently and without potential human error.

NOTE: Applicants amendment to add the phrase "high throughput" does not change the steps of the claim. This phrase fails to appear anywhere within the body of the claim and is given no patentable weight. Additionally, the phrase "under program code", is also not given patentable weight because this phrase or concept also fails to appear within the body of the claim.

With respect to the limitation of claim 2, the reference discloses that the base oil comprises mineral lubricating oils. Additionally, the reference discloses that the compositions of the invention are useful as additives in animal and vegetable oils as well.

With respect to the limitation of claims 3-5, the reference to Karll et al. discloses that the additive is a Mannich product that is used to improve the dispersancy properties of the oil. A number of samples, as shown in TABLE I are compared.

With respect to the limitations of claims 6-8, the reference to Karll et al. discloses that the additive is thoroughly mixed with used crankcase oil having sludge contained within.

With respect to the limitation of claim 28, the reference to Karll et al. discloses that that the Mannich additive product was diluted with oil, see EXAMPLE 2.

7. Claims 26, 27, 29, and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,427,834 (Martin) in view of In re Venner as applied to claim 1 above, and further in view of US 2004/0123650 (Kolosov et al.).

With respect to the limitations of claim 26, the reference to Martin fails to disclose converting the information to a digital signal and sending the information to a microprocessor. The reference to Kolosov et al. discloses an apparatus for high throughput rheological testing of material, whereby the apparatus is employed to screen flowable samples, such as oil. Additionally, the apparatus is used to analyze the resulting properties of a particular flowable material or the relative or comparative effects that an additive has upon a particular flowable sample material. The reference to Kolosov et al. discloses the use of a computer or microprocessor to receive and sore data, such as responses of samples. Providing automation and a microprocessor to an apparatus or process that engages in multiple sampling would be obvious to one of ordinary skill in the art as a means of eliminating human interference which would help to speed up the sampling, processing, and storage of the collected information.

With respect to the limitations of claim 27, the reference to Martin fails to disclose creating a combinatorial library of oil composition from a stored database. The reference to Kolosov et al. discloses an apparatus for high throughput rheological testing of material. The reference discloses that the same apparatus is utilized to

screen and categorize a library of samples. Providing the apparatus to construct a library of samples would have been obvious to one of ordinary skill in the art as a means of allowing one to cross reference unknown compositions with known samples for more accurate sampling and assessment.

With respect to the limitations of claim 29, the reference to Martin discloses a method for screening lubricant and additive performance utilizing a plurality of samples contained on a substrate, wherein the sample comprises, a major amount of at least one base oil; a minor amount of a lubricating additive; and a base insoluble-oil material mixed with the oil and additive mixtures. The dispersancy of each sample is measured and recorded as a ratio in TABLE I, col. 11, lines 20-68. The reference to Martin fails to disclose a plurality of test receptacles, receptacle moving means; and transferring the dispersancy data a computer controller. The reference to Kolosov et al. discloses an apparatus for high throughput rheological testing of material, whereby the apparatus is employed to screen flowable samples, such as oil. Additionally, the apparatus is used to analyze the resulting properties of a particular flowable material or the relative or comparative effects that an additive has upon a particular flowable sample material. The reference to Kolosov et al. further discloses the use of a computer or microprocessor to receive and sore data, such as responses of samples. Providing automation and a microprocessor to an apparatus or process that engages in multiple sampling would be obvious to one of ordinary skill in the art as a means of eliminating human interference which would help to speed up the sampling, processing, and storage of the collected information.

With respect to the limitation of claim 35, the reference to Martin disclose that the base oil is a natural oil.

With respect to the limitation of claims 36 and 37, the reference to Martin discloses that two different ashless dispersants, Amoco 9250 and Lubrizol 6401, were used in comparison dispersancy tests.

With respect to the limitations of claim 38, the reference to Martin discloses a method for screening lubricant and additive performance utilizing a plurality of samples contained on a substrate, wherein the sample comprises, a major amount of at least one base oil; a minor amount of a lubricating additive; and a base insoluble-oil material mixed with the oil and additive mixtures. The dispersancy of each sample is measured and recorded as a ratio in TABLE I, col. 11, lines 20-68. The reference to Martin fails to disclose creating a combinatorial library of oil composition from a stored database. The reference to Kolosov et al. discloses an apparatus for high throughput rheological testing of material. The reference discloses that the same apparatus is utilized to screen and categorize a library of samples. Providing the apparatus to construct a library of samples would have been obvious to one of ordinary skill in the art as a means of allowing one to cross reference unknown compositions with known samples for more accurate sampling and assessment.

8. Claims 30, 31, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,427,834 (Martin) in view of In re Venner and US 2004/0123650

(Kolosov et al.) as applied to claim 29 above, and further in view of US 6,451,259 (Cohen et al.).

With respect to the limitation of claim 30, the references to Martin and Kolosov et al. both fail to disclose receptacle moving means that comprise a movable carriage. The reference to Cohen et al. discloses that the receptacles are held within a rack which is mounted on a rail for movement within an analyzer. Providing a movable carriage for the receptacles would have been obvious to one of ordinary skill in the art as a means of increasing the positional flexibility of the analyzer by allowing the receptacles to move.

With respect to the limitation of claim 31, the reference to Martin and Kolosov et al. both fail to disclose a robot arm that grasps and moves an individual receptacle. The reference to Cohen et al. disclose that after the test tubes are output from modules in the instrument after processing, a robot arm grasps the test tubes and places them in a front most rack until that rack is full of test tubes. Providing a robotic arm to move samples would have been obvious to one of ordinary skill in the art as a means of increasing the positional flexibility of the analyzer by allowing the receptacles to undertake different tests out of any particular order.

With respect to the limitations of claim 33, the references to Martin and Kolosov et al. fail to disclose the placement of a bar code on each receptacle. The reference to discloses that each receptacle is provided with a bar code. Labeling each receptacle with a bar code would have been obvious to one of ordinary skill in the art as an efficient

means of identifying the contents of a receptacle and identifying the location of each sample in the analyzer.

With respect to the limitations of claim 34, the references to Martin and Kolosov et al. fail to disclose the utilization of a bar code reader. The reference to discloses that a bar code reader is utilized to read the bar code on each receptacle. Providing a bar code reader would have been obvious to one of ordinary skill in the art as an efficient means of identifying the contents of a receptacle and identifying the location of each sample in the analyzer.

Response to Arguments

9. Applicant's arguments with respect to claims 1-8, 19-24, and 26-38 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

10. The following is an examiner's statement of reasons for allowance:

Prior art was not relied upon to reject claims 9, 10 and 39 because the prior art fails to teach and/or make obvious the following:

Claims 9 and 10: Providing a method for screening lubricating oil composition samples for dispersancy performance, comprising the step of measuring the kinematic viscosity of each sample at a predetermined temperature to provide dispersancy performance data results in combination with all of the remaining limitations of the claim.

Claim 39: Providing a system for screening lubricant performance, comprising means for measuring the dispersancy performance of the sample in the testing station comprising measuring the kinematic viscosity of each sample at a predetermined temperature to obtain dispersancy performance data associated with the sample and for transferring the dispersancy performance data to a computer controller in combination with all of the remaining limitations of the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Larkin whose telephone number is 571-272-2198. The examiner can normally be reached on 8:00 AM - 5:00 PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Larkin
AU 2856
06 March 2006

DANIEL S. LARKIN
PRIMARY EXAMINER